



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,959	01/30/2002	Donald L. Brodigan	20366-058010	3909

20350 7590 04/20/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

DESIR, JEAN WICEL

ART UNIT	PAPER NUMBER
----------	--------------

2614

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062,959

Applicant(s)

BRODIGAN, DONALD L.

Examiner

Jean W. Désir

Art Unit

2614

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 1-11 is/are allowed.
6) ☒ Claim(s) 12-14 and 18-27 is/are rejected.
7) ☒ Claim(s) 15-17 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 12-14, 18-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al (US 5,835,565).

Claim 12:

Smith discloses:

coupling a test device (item 100 of Fig. 1) to the user drop (item 102, of Fig. 1, which constitutes the user drop); receiving a signal at the test device via the user drop, wherein the signal comprises a first signal type and a second signal type – and measuring the signal to determine the performance capability of the user drop (col. 2 lines 33-59).

Claim 13 is disclosed, see col. 11 lines 29-31.

Claim 14 is disclosed, see col. 10 lines 46-47.

Claim 18 is disclosed, see col. 2 lines 50-59.

Claim 19 is disclosed, see col. 11 lines 12-14, 29-31.

Claim 20:

Smith discloses:

a test device (Fig. 1 items 100, 102); wherein the test device comprises a user drop port (Fig. 1 item 102), at least one input/output port, and is configured to test the performance capability of the user drop (col. 2 lines 50-59); wherein the user drop port is configured for receiving information via the user drop – and wherein the input/output port is configured to provide access to the test device via an external input/output device (col. 2 lines 33-59).

Claim 21 is disclosed, see Fig. 2 which is considered as a set-top box as claimed, the set-top box has a database (item 204) which stored unique type and subtype value as claimed (see also col. 4 line 66 to col. 5 line 6).

Claims 22, 23 are disclosed, see col. 11 lines 22-31, col. 10 lines 46-47, Fig. 1 item 116.

Claim 24 is disclosed, see col. 11 lines 5-31, col. 5 lines 25-35.

Claims 25, 26 are disclosed, see Fig. 1 item 116.

Claim 27 is disclosed, see col. 3 lines 25-39.

Response to Arguments

3. Applicant's arguments regarding the Smith reference have been fully considered but they are not persuasive.

Regarding claim 12, Applicant argues on pages 11 and 12 of the REMARKS that Smith does not teach the elements "receiving a signal at the test device" and "measuring the signal to determine the performance capability of the user drop". These

arguments are not persuasive, Smith does teach the claimed invention as claimed and as pointed out in the rejection because a response data (which is a signal) is received at the test device (item 100 of Fig. 1), see also col. 3 lines 25-30 for further evidence; and - measuring the signal to determine the performance capability of the user drop- is also taught by Smith which detects and evaluates the response data (the signal) to determine if the system 102 (which has been considered as the user drop) operates (performs) properly, see also col. 3 lines 25-39 for further evidence, in other words, by detecting and evaluating the response (the signal) Smith measures the signal to determines the performance capability of the user drop (system 102).

The Applicant's arguments regarding claims 13 and 14, on pages 12 and 13 of the REMARKS, are not persuasive for the same reasons discussed above, regarding claim 12; because Smith measures the signal to determines the performance capability of the user drop, this performance capability comprises video performance capability because Smith's disclosure is capable of processing signal that includes video data (see again col. 11 lines 29-31).

Regarding claim 20, Applicant argues on page 13 of the REMARKS that Smith does show several ports, each of those appear to be connected to the telecommunication system under test, not to an external input/output device". Smith does provide access to the test device via an external input/output device as claimed and as pointed out in the rejection, because Smith also includes feature for **importing** data (see also col. 8 lines 41-47 for further evidence), and Smith also shows that the

test device is also connected to device 104 (see Fig. 1 item 104) which is considered as an external input/output device as claimed.

Regarding claim 22, contrary to the Applicant's arguments on page 14 of the REMARKS, Smith does teach that his system has the capability of processing video data (see again col. 11 lines 21-31, specifically lines 30-31), and the video data is considered as included MPEG video data.

Allowable Subject Matter

4. Claims 15-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claims 1-11 are allowed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean W. Désir whose telephone number is (703) 308 9571. The examiner can normally be reached on 5/4/9 - First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (703) 305 4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD
Apr. 13, 04


MICHAEL H. LEE
PRIMARY EXAMINER